



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,532	09/11/2002	Zhibo Gan	45460-1	3042

7590

03/22/2006

Richard S Milner
Cooper & Dunham
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

VENCI, DAVID J

ART UNIT	PAPER NUMBER
----------	--------------

1641

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,532

Applicant(s)

GAN, ZHIBO

Examiner

David J. Venci

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 3, 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 12-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/16/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Examiner acknowledges Applicant's election of Invention I, with traverse, in the reply filed on January 3, 2006. Applicant traverses by positing that a simultaneous search and examination of all the Inventions will not result in a serious examination burden. Examiner respectfully disagrees.

According to PCT Rules 13.1 and 13.2, if all Inventions fail to relate to a single general inventive concept, i.e. the Inventions lack the same or corresponding special technical feature, then restriction based on lack of unity is proper. PCT Rules 13.1 and 13.2 do not appear to require a showing of examination burden.

As set forth by the previous Examiner, claims 1-25 fail to relate to a single general inventive concept, and therefore lack the same or corresponding special technical feature, because Invention I requires a competitive interaction, while Invention II requires a hydrolytic interaction, while Invention III requires an inhibitory interaction. The restriction requirement is deemed proper and is made FINAL.

Claims 12-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected Inventions.

Currently, claims 1-11 are under examination.

Claim Objections

Claim 1 is objected to because of various formatting and/or punctuation errors. Specifically, claim 1 contains multiple sentences and/or periods in the middle of the claim. Appropriate correction is required.

Art Unit: 1641

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Throughout the claims:

The recitation of ordinal and/or class descriptors "1", "2" and "3" is indefinite. The identity of object(s) belonging to each class descriptor is not clear. The standard for ascertaining membership to each class is not clear.

In claim 1:

The preamble recitation of "the biological substances" lacks antecedent basis. The identity of object(s) belonging to the class "biological substances is not clear.

In steps (a) and (b), the identity of one or more required step limitations, if any, is not clear. For example, whether step (a) requires the steps of "providing" a surface of a vessel and/or "coating" a surface with reactant is not clear. Whether step (b) requires the steps of "providing" a known amount of reactant and/or "linking" a label is not clear.

In step (a), the phrase "the surface" lacks antecedent basis.

In step (a), the passive voice recitation "the surface... coated" is indefinite. The identity of object(s) and/or step(s), if any, required for performing coating is/are not clear.

Art Unit: 1641

In step (b), the passive voice recitation "reactant 3 linked" is indefinite. The identity of object(s) and/or step(s), if any, required for performing linking is/are not clear.

In step (b), the phrase "The competitive reactions" lacks antecedent basis.

In step (b), the recitation of the infinitive "to bind" is indefinite. Whether the act or process of binding is completed or performed, or merely intended, is not clear.

In step (c), the phrases "the label signal" and "the reaction vessel" lack antecedent bases.

In claim 11:

The phrase "selected from the group of" is indefinite. Whether a Markush-type claim is intended is not clear.

Art Unit: 1641

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Maggio (US 4,277,437).

Maggio describes a competitive method (see Abstract, first sentence) for measuring a biological substance (see col. 7, lines 60-68) comprising the steps:

(a) providing a surface of a vessel (see col. 18, lines 50-61, "hub nucleus") coated with a reactant (see col. 3, lines 22-30, "[l]igand analog");

(b) providing a labeled reactant (see col. 3, lines 50-62, "[l]abel-conjugate") and an unknown reactant (see col. 3, lines 15-19, "[a]nalyte"); and

(c) determining a change in label signal (see Abstract, "change in light emission in relation to the concentration of analyte").

Art Unit: 1641

Conclusion

No claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Venci whose telephone number is 571-272-2879. The examiner can normally be reached on 08:00 - 16:30 (EST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David J Venci
Examiner
Art Unit 1641

djv


LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

03/20/06